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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,853	06/24/2003	Yung-Nien Chang	4-31401A	9278
29585	7590	11/02/2006		EXAMINER
		DLA PIPER RUDNICK GRAY CARY US LLP		LONG, SCOTT
		153 TOWNSEND STREET		
		SUITE 800	ART UNIT	PAPER NUMBER
		SAN FRANCISCO, CA 94107-1907		1633

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/602,853	CHANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Scott D. Long	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 38-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 38-96 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

The examiner has received and acknowledges the claim amendments, specification amendments, and traversal to obvious double patent rejection submitted by applicant on 28 September 2006.

### ***Claim Status***

Claims 38-96 are pending. Claims 38, 51, 64, 84, 86, 90 have been amended.

### ***Claim Objections***

Objections to claims 38, 51, 84, 86, 90 are hereby withdrawn, due to claim amendments submitted by applicant.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claim 64 under 35 U.S.C. 112, second paragraph is hereby withdrawn. The claim amendment submitted by applicant removes vagueness and indefiniteness.

### ***Double Patenting***

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The applicant respectfully submitted that the present claims are not obvious in view of the claims of the cited patent. The applicant further indicated that if the examiner indicated that all other outstanding issues are resolved, the applicant would file a terminal disclaimer. The examiner disagrees with the applicant's traversal and maintains the obvious double patent rejection, particularly since the terminal disclaimer has not been filed.

Claims 38-96 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-18 and 20 of U.S. Patent No. 5,998,205. Although the conflicting claims are not identical, they are not patentably distinct from each other. Because the argument submitted by applicant, received by the Office on 28 September 2006, fails to specifically describe why the present claims

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are not obvious in view of the cited patent, the rejection, as reiterated below, is maintained.

Claims 12-18 and 20 of the cited patent are directed to an isolated cell containing a tissue-specific replication-conditional adenovirus virion and methods of producing said adenovirus virion. Claims 38-96 of instant application are directed to a virion comprising the adenoviral vector of the cited patent, cells comprising the virion, and method of producing said virion. The instantly claimed virion is fully disclosed in the specification of the cited patent. For example, claim 12 of the cited patent refers to an isolated cell containing an adenovirus virion and claim 18 refers to methods of producing said adenovirus virion. Furthermore, in the specification of the cited patent, virions are produced and recovered by inventors and are therefore possessed by inventors, "In further embodiments, a method is provided for producing a replication-conditional vector or virion comprising the steps of culturing the producer cell line described above and recovering the vector or virion from the cells" (column 5, lines 27-30).

Accordingly, instant claims and the claims of the cited patent are obvious variants. Therefore, the inventions as claimed are co-extensive.

### **CONCLUSION**

No Claims Allowed. However, the only outstanding rejection is the Obvious Double Patent rejection.

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***Examiner Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Scott Long** whose telephone number is **571-272-9048**.

The examiner can normally be reached on Monday - Friday, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dave Nguyen** can be reached on **571-272-0731**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Long  
Patent Examiner  
Art Unit 1633

  
**DAVE TRONG NGUYEN**  
**SUPERVISORY PATENT EXAMINER**